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**DEC 24 2008**

**OFFICE OF PETITIONS**

In re Application of  
Nishida et al.  
Application No. 08/295686  
Filing or 371(c) Date: 08/24/1994  
Attorney Docket Number: 52433354

**DECISION  
ON PETITION**

This is a decision on the "Request for Reconsideration of Petition Under 37 C.F.R. § 1.137(a) and Transmittal of Petition Under 37 C.F.R. § 1.181 to Withdraw Holding Of Abandonment," filed November 21, 2008, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition under 37 C.F.R. § 1.137(a) is hereby **dismissed**.

A Decision on the petition under 37 C.F.R. § 1.181 is **dismissed as untimely**

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

**Background**

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed March 24, 1995. The Office action set a extendable three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No complete and proper reply having been received, the application became abandoned on June 25, 1995. A Notice of Abandonment was mailed October 17, 1995.

**The petition (originally filed September 22, 1995 (Certificate of Mailing dated September 20, 1995))**

Applicant files the present petition, and asserts that timely reply to the Office action, including a request for a three (3) month extension of time and fee, were filed on September 22, 1995 (Certificate of Mailing dated September 20, 1995). In support of this assertion, Applicant files a

copy of the reply, and a copy of Applicant's return-receipt postcard acknowledging receipt by this Office of a Response and an Extension Request on September 22, 1995. A review of the copy of the reply filed with the petition reveals that the reply contains a Certificate of Mailing under 37 CFR 1.8 dated September 20, 1995, and executed by Petitioner herein.

Office records do not indicate receipt of the reply on or about September 22, 1995, or the petition on or about November 7, 1995. Office records do, however, reveal that the fee for a three (3) month extension of time was received in this Office on September 22, 1995, and the fee for a petition to revive an application abandoned unavoidably was received in this Office on November 9, 1995.

The petition was dismissed in a Decision mailed September 22, 2008, because Applicant had failed to demonstrate diligence in prosecuting the application. The Decision dismissing the petition stated that the delay in prosecuting the application in this instance is more than 12 years, and the burden of continuing the process of presenting a grantable petition in a timely manner remains with the applicant until the applicant is informed that the petition is granted. See In re Application of Takao, 17 USPQ2d 1155, at 1158 (Comm'r Pat. 1990). The Decision noted that Applicant has the duty to make sure his application is being prosecuted. Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1962). Moreover, diligence on the part of the applicant is essential to show unavoidable delay. See, Future Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431 (E.D. Va. 1988). Diligent inquiry into the status of the application is required. Id.

### **The present petition**

Applicant files the present petition and attempts to differentiate the case law from the facts of the present case, and states that in the present case, Applicant timely and diligently filed the petition, including the requisite extension of time, and it is this Office that failed to timely act on the petition. The petition ignores Petitioner's duty to make sure his application is being prosecuted. Petitioner has not provided any explanation as to why more than 12 years passed without any action on the part of Petitioner to make sure that his application was being processed.

Petitioner also files a petition under 37 CFR 1.181 and asserts that the petition is being filed in response to the Decision on Petition mailed September 22, 2008, but also petitions "to withdraw the holding of abandonment of the above-identified application by the Notice of Abandonment mailed October 17, 1995."

### **A Grantable Petition Under 37 CFR 1.137(a)**

In November, 1995, the showing required for a grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) A proposed response to continue prosecution of the application, or the filing of a continuing application, unless either has been previously filed;
- (2) The petition fee as set forth in § 1.17(l); and

(3) A showing that the delay was unavoidable. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office.

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition lacks item (4).

As to item (4), since the above-identified application was filed before June 8, 1995, 37 CFR 1.137(d) requires a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted on the application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application.

37 CFR 1.37(d), Terminal disclaimer, states:

- (1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any petition to revive pursuant to this section in either a utility or plant application filed before June 8, 1995, must be accompanied by a terminal disclaimer and fee as set forth in § 1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the lesser of:
  - (i) The period of abandonment of the application; or
  - (ii) The period extending beyond twenty years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application(s) under 35 U.S.C. 120, 121, or 365(c), from the date on which the earliest such application was filed.
- (2) Any terminal disclaimer pursuant to paragraph (d)(1) of this section must also apply to any patent granted on a continuing utility or plant application filed before June 8, 1995, or a continuing design application, that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought.
- (3) The provisions of paragraph (d)(1) of this section do not apply to applications for which revival is sought solely for purposes of copendency with a utility or plant application filed on or after June 8, 1995, to lapsed patents, to reissue applications, or to reexamination proceedings.

#### A Grantable Petition Under 37 CFR 1.181

37 CFR 1.181(f), states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under

this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

**Analysis**

Here, the petition is filed "to withdraw the holding of abandonment of the above-identified application by the Notice of Abandonment mailed October 17, 1995." The petition, filed more than 13 years after the mailing of the Notice of Abandonment, is properly dismissed as untimely.

**Conclusion**

In view of the foregoing, the petition under 37 CFR 1.137(a) is dismissed for lack of a Terminal Disclaimer, and no objection having been received within two (2) months of the mail date of the Notice of Abandonment, mailed October 17, 1995, the petition under 37 CFR 1.181 is dismissed as untimely.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

By FAX: (571) 273-8300  
Attn: Office of Petitions

By hand: Customer Service Window  
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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/  
Derek L. Woods  
Attorney  
Office of Petitions

Enclosure: Terminal Disclaimer Form